

REMARKS

This application is amended in a manner believed to place it in condition for allowance at the time of the next Official Action.

Claims 13, 14, and 16 are amended.

Claims 17-20 are new.

Support for the amended and new claims may be found generally throughout the present specification, for example, at page 3, line 24 to page 7, line 4 and 8, lines 7-24.

Claim 15 is cancelled.

Claims 1-14 and 16-20 remain pending.

Responsive to the preliminary determination of lack of unity set forth in the outstanding Official Action, applicants provisionally elect group (V), claims 13, 14, 16, with traverse. New claims 17-20 are directed to the provisionally elected invention.

Responsive to the election of species requirement, applicants provisionally elect 2-ethoxy-7-carboxy-1H-benzimidazol-1-yl for the Z residue of claim 14, with traverse. Claims 13, 14, 16-20 are readable on the elected species.

The reasons for traverse are as follows.

With respect to claims 1-4, claims 1-4 are directed to a process of forming a formula (II) compound. Claims 13, 14, 16-20 are directed to a method of using a compound of formula (V) to prepare a compound of formula (I). In claim 17, the formula (II)

compound is formed by the same reaction recited in claim 1, which requires the formula (V) compound, and the formula (II) compound forms the formula (I) compound. Thus, as claim 17 shares the same steps of preparing the formula (II) compound, at the very least, claims 1-4 should be examined along with the elected invention.

As to claims 8, 9, and 10, the compounds of claim 10 are directed to a single inventive concept with the subject matter of claims 8 and 9. These claims share the same classification and they share the same distinguishing feature, i.e., a methyl-phenyl-ethyl group and $-B(OR_4)_2$ group.

With respect to claims 11 and 12, claim 16 of the elected invention requires the formula (V) compound defined by claim 12. Also, claim 13 requires the formula (V) compound of claim 11. Thus, a full search for formula (V) compound used in the method of preparation in claims 13 and 16 would yield prior art relevant to both claims 11 and 12.

As to the election of species requirement, the species of the present invention are directed to subject matter in which a search and examination may be completed within a narrow discipline. The species are directed to compound of formula (I), and it is respectfully submitted that these individual species of claim 14 are sufficiently closely related that a full search for the use of a compound of formula (V) to prepare a compound of formula (I) would yield all prior art relevant to each species.

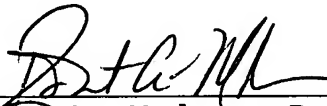
Moreover, in applying the same legal standard with similar claims, the International Search Authority did not determine the unity of invention as lacking. Thus, the Patent Office has the benefit of the search report, but fails to explain why a different legal conclusion was reached.

In view of the above, it is believed that the applicants are entitled to an action on the merits of all pending claims, in their full scope, in the present application. Such an action is accordingly respectfully requested.

The Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 25-0120 for any additional fees required under 37 C.F.R. § 1.16 or under 37 C.F.R. § 1.17.

Respectfully submitted,

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